



Paper No. 8

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COPY MAILED**MAR 24 2003****OFFICE OF PETITIONS**

In re Application of
Thomas E. Dungan
Application No. 10/066,205
Filed: June 27, 2002
Attorney Docket No. DTE-101-C

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DECISION ON PETITION

This is a decision on the "Petition to Correct Filing Date," filed September 16, 2002, requesting that the above-identified application be accorded a filing date of October 29, 2001. Petitioner requests that papers purportedly deposited in the USPS on October 29, 2001, but not received in the Office until February 5, 2002 be considered filed October 29, 2001. This request is properly treated as a petition under § 1.10. Petitioner further requests that the application though considered filed without drawings be accorded a filing date of October 29, 2001, by virtue of the incorporation by reference of the subject matter of the previous patent, including drawings. This request is properly treated as a petition under § 1.182.

BACKGROUND

Application papers in the above-identified application were received on February 5, 2002. However, on March 20, 2002, the Office of Initial Patent Examination mailed a "Notice of Incomplete Nonprovisional Application," notifying applicants that the application papers had not been accorded a filing date because the application was deposited without drawings.

On June 27, 2002, petitioner filed the drawings with an explanation as to why drawings were believed not necessary. No petition requesting that the application be accorded the earlier filing date of October 29, 2001 accompanied the drawings. The Office accorded the application a filing date of June 27, 2002, and mailed a new filing receipt to applicants.

In response, petitioner filed the instant petition. Herein, petitioner asserts that the application is entitled to a filing date of October 29, 2001. Petitioner does not argue that drawings were among the papers filed on October 29, 2001. Rather, petitioner asserts that by virtue of the incorporation by reference of the subject matter of the previous patent, drawings should be considered present in the application and a filing date of October 29, 2001 accorded.

RELEVANT STATUTES, RULES AND REGULATIONS

35 USC 111(a)(4) provides, in pertinent part, that:

The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

37 CFR § 1.10(a) provides that:

Any correspondence received by the Patent and Trademark Office (Office) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS. The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the Office receipt date as the filing date. See § 1.6(a).

MPEP 201.06 provides, in pertinent part, that:

Material needed to accord an application a filing date may not be incorporated by reference. Therefore, if a continuation or divisional application as originally filed incorporates by reference material omitted from the application papers, which is needed to accord the application a filing date, the application will not be entitled to a filing date. A petition under 37 CFR 1.182 and the required petition fee, including an amendment submitting the necessary omitted material, requesting that the necessary omitted material contained in the prior application and submitted in the amendment, be included in the continuation or divisional application based upon the incorporation by reference statement, is required in order to accord the application a filing date as of the date of deposit of the continuation or divisional application. An amendment submitting the omitted material and relying upon the incorporation by reference will not be entered in the continuation or divisional application unless a decision granting the petition states that the application is accorded a filing date and that the amendment will be entered.

MPEP 503 provides that:

... A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

...

The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the

components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.

CONSIDERATION OF PETITION UNDER 1.10

On petition, petitioner states that "on October 29, 2001, the instant application was received at the Patent Office (See Ex. A) and assigned Serial No. 10/066,205. The return postcard had a date of February 5, 2002 (See Ex. B)." Given this statement, it must be preliminary stated that the application assigned No. 10/066,205 was not received in the Office on October 29, 2001. Rather, it was as reflected on the postcard first received on February 5, 2002.

A review of the application papers received on February 5, 2002 reveals that they include an indication that the papers may have been delivered to the Office by the "Express Mail Post Office to Addressee" service of the USPS. Noted on the application cover sheet are "Express Mail" mailing label No. EL735315300US and a date of deposit of October 29, 2001. Accordingly, this petition is first construed as a petition to accord the application papers received on February 5, 2002, a date of receipt of October 29, 2001, pursuant to 37 CFR § 1.10(a).

Unfortunately, petitioner has not submitted the evidence required to show a date of deposit of October 29, 2001 in USPS "Express Mail" service. Specifically, petitioner has not submitted a copy of an "Express Mail" mailing label showing a "date-in" of October 29, 2001, as required. A certificate of mailing does not meet the requirements of 37 CFR § 1.10.

In considering this petition, it is recognized that there were postal service delays in the delivery of mail to the Office in October of 2001. However, at the same time, petitioner is reminded of the Notices¹ to practitioners directing their action

¹ As provided in Notice dated November 8, 2001, entitled "Mitigation of Delays in Mail Deliveries to the USPTO"

As authorized by 35 U.S.C. § 21(a), 37 CFR 1.10 permits the USPTO to treat correspondence delivered by the "Express Mail Post Office to Addressee" service of the USPS as being filed in the USPTO on the date of deposit with the USPS as shown by the "date in" on the "Express Mail" mailing label. Use of this procedure can, therefore, obviate risks of delay in postal delivery. Those utilizing the procedure under 37 CFR 1.10 are encouraged to inspect the mailing label receipt to ensure that the "date in" portion of the mailing label is accurate and legible. This procedure is particularly useful for the filing of national and international patent and trademark applications and for the filing of any paper for an application subject to the Patent Term Adjustment (PTA) provisions of the American Inventors Protection Act of 1999 (plant or utility patent application filed on or after May 29, 2000).

Express Mail: If the patent application was originally submitted using the "Express Mail" mailing procedures set forth in 37 CFR 1.10, applicant should first check with the USPS for confirmation of delivery to the USPTO. Status may be checked using the track/confirm feature on the USPS's Web site at <http://www.usps.com/shipping/epstrac.htm>. If the USPS does not confirm delivery of the patent application to the USPTO, applicant should promptly

in response to any delay experienced. Further, the evidence (or lack thereof) provided on instant petition must be considered consistent with these Notices and with the relevant rules of practice. Regardless of the postal service delays, it has been required that an applicant show compliance with § 1.10 by providing a copy of an "Express Mail" mailing label showing the requested date of deposit as the "date-in" or by other official USPS notation, and that such petitions be filed promptly. See 37 CFR 1.10(c), (d) and (e).

Accordingly, the instant petition under § 1.10 must be **DISMISSED**.

The application continues to be considered deposited (without drawings) on February 5, 2002.

CONSIDERATION OF PETITION UNDER 1.182

Petitioner also requests that the application though considered filed without drawings be accorded a filing date of October 29, 2001, by virtue of the incorporation by reference of the subject matter of the previous patent, including drawings. Absent a showing that the application papers were deposited pursuant to § 1.10 on October 29, 2001, this request is being considered as a request that the application though considered deposited without drawings be accorded a filing date of February 5, 2002, by virtue of the incorporation by reference of the subject matter of the previous patent, including drawings.

As set forth in MPEP 201.06, recited above, a continuation or divisional application that as originally filed incorporates by reference material omitted from the application papers, which is needed to accord the application a filing date, may be accorded a filing date as of the date of filing of the continuation or divisional application upon the filing of a petition under 37 CFR 1.182, the required petition fee, and an amendment submitting the necessary omitted material, requesting that the necessary omitted material contained in the prior application and submitted in the

file a petition under 37 CFR 1.10(e) (as discussed below).

...

If the patent application was originally submitted using the "Express Mail" mailing procedures set forth in 37 CFR 1.10 and the OIPE customer service center is unable to locate the application, applicant should promptly file a petition under 37 CFR 1.10(e) (no fee required) including:

- (1) a copy of the "Express Mail" mailing label showing the "date-in" (or copy of any other official notation by the USPS relied upon to show the date of deposit);
- (2) a copy of the originally deposited application papers showing the number of the "Express Mail" mailing label as placed on the originally deposited papers; and
- (3) a statement that the copy of the "Express Mail" mailing label and copy of the originally deposited application papers are true copies of the "Express Mail" mailing label and originally deposited application papers.

If the petition complies with the requirements of 37 CFR 1.10(e) and the application is otherwise entitled to a filing date, the USPTO will accord the application a filing date as of the date the patent application was originally deposited with the USPS as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation.

amendment, be included in the continuation or divisional application based upon the incorporation by reference statement. An applicant incorporates by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter.

Unfortunately, a line-by-line review of this application-as-filed, including the application transmittal letter, reveals that it does not contain an incorporation by reference statement.

In view thereof, the petition under § 1.182 must be **DISMISSED**.

It is further noted that the return postcard supplied is not sufficiently itemized to serve as *prima facie* evidence that drawings were among the application papers filed on February 5, 2002. The return postcard requests acknowledgement generally of the receipt of "Patent Application (22 pages)." See MPEP 503.

This application is being forwarded to the Office of Initial Patent Examination (OIPE) for according of a filing date of June 27, 2002, using the application papers received in the Office on February 5, 2002 and the drawings received on June 27, 2002.

Telephone inquiries specific to this decision should be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.



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